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| PPLICATION NO.  | FILING DATE     | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO |
|---|-----------------|----------------------|-------------------------|-----------------|
| 10/069,973  | 06/17/2002      | Stefan Grimm         | 100564-00107            | 9410            |
| 6449  | 7590 12/16/2004 |                      | EXAM                    | INER            |
| ROTHWELL, FIGG, ERNST & MANBECK, P.C.  1425 K STREET, N.W.  DAVIS, MINH TAM B |                 |                      | NH TAM B                |                 |
| SUITE 800   | ,               |                      | ART UNIT                | PAPER NUMBER    |
| WASHINGT  | ON, DC 20005    |                      | 1642                    |                 |
|   |                 |                      | DATE MAIL ED. 12/16/200 |                 |

Please find below and/or attached an Office communication concerning this application or proceeding.

|  | Application No.   | Applicant(s)  | <del></del> |  |  |  |
|--|---|---|-------------|--|--|--|
|  | 10/069,973  | GRIMM ET AL.  |             |  |  |  |
| Office Action Summary  | Examiner  | Art Unit  | :           |  |  |  |
|  | MINH-TAM DAVIS  | 1642  |             |  |  |  |
| The MAILING DATE of this communication appears on the cover sheet with the correspondence address<br>Period for Reply  |   |   |             |  |  |  |
| A SHORTENED STATUTORY PERIOD FOR REPL' THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a repl - If NO period for reply is specified above, the maximum statutory period Failure to reply within the set or extended period for reply will, by statute - Any reply received by the Office later than three months after the mailing - earned patent term adjustment. See 37 CFR 1.704(b). | 36(a). In no event, however, may a reply be time y within the statutory minimum of thirty (30) days will apply and will expire SIX (6) MONTHS from a cause the application to become ABANDONED                    | ely filed s will be considered timely, the mailing date of this comr 0 (35 U.S.C. § 133). | nunication. |  |  |  |
| Status   |   | ~   |             |  |  |  |
| 1) Responsive to communication(s) filed on 17 July   | <u>une 2002</u> .   |   |             |  |  |  |
| 2a) ☐ This action is <b>FINAL</b> . 2b) ☐ This   | action is non-final.  |   |             |  |  |  |
|  | Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. |   |             |  |  |  |
| Disposition of Claims  |   |   |             |  |  |  |
| 4) ⊠ Claim(s) 32-55 is/are pending in the applicatio 4a) Of the above claim(s) is/are withdray 5) □ Claim(s) is/are allowed. 6) □ Claim(s) is/are rejected. 7) □ Claim(s) is/are objected to. 8) ⊠ Claim(s) 32-55 are subject to restriction and/or  | wn from consideration.  |   |             |  |  |  |
| Application Papers   |   |   |             |  |  |  |
| 9) The specification is objected to by the Examine   | er.   |   |             |  |  |  |
| 10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.  |   |   |             |  |  |  |
| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  |   |   |             |  |  |  |
| Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Ex  | •   |   | • •         |  |  |  |
| Priority under 35 U.S.C. § 119   | •   |   |             |  |  |  |
| 12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:  1. Certified copies of the priority document 2. Certified copies of the priority document 3. Copies of the certified copies of the prio application from the International Bureau * See the attached detailed Office action for a list   | s have been received. s have been received in Application rity documents have been receive u (PCT Rule 17.2(a)).  | on No<br>d in this National St  | age         |  |  |  |
| Attachment(s)  |   |   |             |  |  |  |
| 1) Notice of References Cited (PTO-892)  | 4) Interview Summary Paper No(s)/Mail Da  |   |             |  |  |  |
| <ul> <li>2) Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)</li> <li>Paper No(s)/Mail Date</li> </ul>   |   | atent Application (PTO-1  | 52)         |  |  |  |

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## **DETAILED ACTION**

## Election/Restrictions

Claims 32-55 are pending. After analysis, it is noted that claim 54 is listed as dependent on claim 43, and for purposes of restriction is included with claim 43. However, it appears from the content of claims 53 and 54 that Applicant may have intended claim 54 to be dependent on claim 53. It is suggested that Applicant reviews claim 54.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group 1**, claim(s) 32-43, 54, drawn to a method for inhibition of apoptosis or treating diseases associated with excessive apoptosis, wherein said disease is degenerative disease.

**Group 2**, claim(s) 32-42, 44, drawn to a method for inhibition of apoptosis or treating diseases associated with excessive apoptosis, wherein said disease is cardiomyopathy. **Group 3**, claims 45-53, 55, drawn to a method for identifying a substance that inhibits the activity of ANT-1.

The inventions listed as Groups 1-3 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

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According to PCT Rule 13.2, unity of invention exists only when the shared same or corresponding technical feature is a contribution over the prior art. The inventions listed as groups 1-3 do not relate to a single general inventive concept because their same or corresponding technical feature is not a contribution over the prior art.

The technical feature of group 1 is inhibition of apoptosis by administration of an inhibitor of ANT-1, which is known in the art. Fulda et al, Cancer Res, 1998, 58(19): 4453-60 teach that apoptosis in neuroblastoma cells is inhibited by bongkrekic acid, which is an inhibitor of ANT-1, as taught by Pei, YZ et al, 2003, Synthesis-Stuttgart, 11, SI, pages 1717-1721. Thus group 1 as a whole lacks novelty or inventive step, and does not make a contribution over the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MINH TAM DAVIS

December 06, 2004

SUSAN UNGAR, PH.D PRIMARY EXAMINER